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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,024	08/20/2003	Peter Joseph Hollands	0142-0442P	5340

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,024

Applicant(s)

HOLLANDS ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10 is/are rejected.
- 7) ☒ Claim(s) 8 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/079,556.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 December 2005 has been entered.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Oldham (U.S. Pat. No. 2,031,786; previously of record).

Oldham discloses a molding apparatus. The apparatus comprises first and second dies (8 and 9) defining a substantially mold cavity (see Fig. 4), with the dies being separable from one another. As evidence from Figure 4, the dies have a wall thickness which is smaller than one-half the average

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diameter of the mold cavity. Both of the dies have a runner hole (14) of sufficient size for the introduction of molding material into the mold cavity. The runner hole of both dies is disposed substantially in the center of the dies (see Fig. 4).

It is noted that claim 1 recites that the defined mold is "for manufacturing pellets of hot-melt ink" and that the runner holes are of size sufficient "for the introduction of ink for the manufacture of [the] pellets into the mold cavity. The use of ink as the molding material in order to produce pellets relates to the intended use of the claimed mold and not the actual mold structure. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCAP 1963); MPEP 2115. Moreover, a claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987); MPEP 2114. In this case, Oldham discloses an apparatus with all of the structural features defined in the claimed mold. Moreover, there does not appear to be any reason why the mold could not be

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used with ink as the molding material. Oldham therefore anticipates the claim, regardless of the recited uses.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered

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therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oldham in view of Simonds (U.S. Pat. No. 6,350,114; previously of record) or Murphy et al. (U.S. Pat. No. 6,769,900; previously of record).

Oldham discloses the mold as described above. Oldham further discloses the mold to have a heating means (including the blowing of hot steam air) operatively associated with the dies (see p. 1, cl. 2, l. 51 - p. 2, cl. 1, l. 3). Oldham further discloses the mold to have vents that could act as runner holes (17) for the introduction of air into the mold cavity. Note the discussion of the use of the apparatus described above.

Oldham does not explicitly disclose the mold to be made of a metal or a metal alloy. The use of metal or metal alloys for the construction of molds of the type disclosed by Oldham is,

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however, well known in the art. Simonds for example, discloses molding dies made from steel or aluminum (see cl. 2, ll. 18-22). Murphy also discloses a mold of the type disclosed by Oldham wherein the mold is made from aluminum (see cl. 29, ll. 20-21). Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have used a metal such as aluminum for the construction of the mold dies disclosed by Oldham because such a metal is well known in the art as suitable for making the molding dies as evidenced by Simonds and Murphy.

8. Applicant's arguments filed 20 December 2005 have been fully considered but they are not persuasive.

Applicant argues that Oldham, nor Simonds, suggests a mold which is specifically designed for the manufacture of pellets of hot melt ink. As such, Applicant asserts that Oldham and Simonds do not contemplate the importance of controlling the wall thickness of the mold cavity.

As described above, the recitation in the claims of the instant application that the mold is for manufacturing pellets of hot-melt ink relates only to the intended use of the claimed apparatus, not any apparatus structure. It is the structure that is determinative of patentability of a claimed apparatus.

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As further described above, Oldham alone, and in combination with Simonds, discloses and suggests all of the structural features of the claims of the instant application. As such, the mere fact that the mold of the instant application is used for a different purpose cannot form a basis for patentability.

With respect to the features of the wall thickness of the mold cavity, as described above, the dies of Oldham have a wall thickness which is smaller than one-half the average diameter of the mold cavity. The fact that Oldham may not recognize the importance of this feature does not form a basis of patentability. The reference in disclosing this wall thickness to cavity relationship anticipates the claims, irregardless of its purpose or recognition of the importance of this feature. Cf. In re Schoenwald, 964 F.2d 1122, 22 USPQ2d 1671 (Fed. Cir. 1992) (finding that in order to constitute anticipatory prior art, a reference must identically disclose the claimed compound, but no utility need be disclosed by the reference).

Applicant also argues that as Oldham discloses four runner hole access points through which the molding material is introduced into the molding cavity under pressure, it does not anticipate claim 1.

The fact that Oldham includes multiple runner holes does not distinguish the claims of the instant application. The

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claims are drawn with open-ended, "comprising" terminology. Additional elements may therefore be included within the claimed apparatus, and hence, the prior art as well. Further, the use of pressure introduced the molding material is not precluded by any limitation of the claims. Therefore, Oldham's structure anticipates the claims, regardless of the multiple runner holes and use of pressure with the molding material.

9. Claim 11 is allowed. Claims 2, 8, and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. See the reasons for indicating allowable subject matter in the previous Office Action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for

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the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).


Donald Heckenberg
Primary Examiner
A.U. 1722

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